



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,530	04/05/1999	L. LAWRENCE CHAPOY	7651/1239	5116

757 7590 12/06/2001

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
----------	--------------

3738

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/286,530

Applicant(s)

CHAPOY ET AL.

Examiner

Paul B. Prebilio

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17,19-22,24-40 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) 24-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-17,19-22,40 and 42-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3738

Claims 24-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6 filed October 23, 2000.

Claim Objections

Claims 4-7 and 19-22 are objected to because of informalities. In each of these claims, "the material" lacks clear antecedent basis. Furthermore, there is more than one material set forth in the independent claim(s). Appropriate correction is required.

Claim Rejections Based Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7, 9-14, 40-42, and 44-53 are rejected under 35 U.S.C. 102(b) as anticipated by Patel (US 5,252,262) or, in the alternative, under 35 U.S.C. 103(a) as

Art Unit: 3738

obvious over Patel (US 5,252,262) in view of Bruns et al (US 4,737,322). Patel discloses that the haptic of the intraocular device can be made of a sheath/core structure of polyimide as one of the materials. For this reason, if the sheath and core were both made of polyimide, the claim language would be fully met; see the whole document, especially Figures 1-3 and 26-29 as well as column 4, lines 5-57.

Alternatively, making the sheath and out of polyimide is not explicitly disclosed so one could interpret Patel as not meeting the claim language fully. Bruns et al, however, teaches that it was known to make haptics out of polyimide in order to provide a high melting polymer for this element; see column 6, lines 25-39. Hence, it is the Examiner's position that it would have been at least obvious to make the sheath and core of Patel out of polyimide for the same reasons that Burns et al does the same; the optic would then contain the silicone polymer, acrylic polymer, hydroacrylic polymer, 2-hydroxyethylmethacrylate polymer, polymethylmethacrylate polymer or combinations thereof.

With regard to claims 2, 9-14 and 44-53, the product-by-process steps are only given weight to the extent that they affect the final product with little burden on the Examiner's part to meet the claim language; see MPEP 2113 which is incorporated herein by reference thereto. Hence, it is the Examiner's position that the claim product-by-process limitations result in an identical, or alternatively, a substantially identical product to that disclosed by Patel such that the claims are clearly unpatentable thereover.

Art Unit: 3738

With regard to claim 40-53, the polyimide as claimed is the same material as that set forth by Patel, such that it would inherently have the same fibrosis promotion affect.

Claims 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel and Bruns et al as applied to claims 1-3, 5, 7, 9-14, 40-42 and 44-53 above, and further in view of Patel et al (US 6,158,862).

With regard to claims 4 and 6, Patel does not disclose a silicone or HEMA (i.e. hydroxylethylmethacrylate) optic as claimed. Patel et al, however, discloses that it was known to make optics out of silicone or HEMA; see column 4, lines 7-14. Hence, it is the Examiner's position that it would have been obvious to make the optic of Patel out of silicone or HEMA for the same reasons the prior art does the same and since there is no criticality to such a selection of materials.

With regard to claim 8, Patel does not disclose the use of a UV absorbing dye as claimed. Patel et al, however, teaches that it was known to make lenses containing UV absorbing dye in order to protect the retina. Hence, it is the Examiner's position that it would have been obvious to do the same with the Patel intraocular optic for the same reasons that Patel does the same.

Claims 15-18, 20, 22, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel and Bruns et al as applied to claims 1-3, 5, 7, 9-14, 40-42 and 44-53 above, and further in view of Cumming (US 5,047,051). Patel meets the claim language except for the footplate or opposing set of plates as claimed. Cumming, however, teaches that it was known to make haptics into opposing plate or footplate forms; see the figures and the rest of the document. Hence, it is the Examiner's

Art Unit: 3738

position that it would have been obvious to make the polyimide haptics of Patel into a plate form and to coat the entire haptics thereof with polyamide for the same reasons that Cumming forms his haptics into that form.

Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel, Bruns et al, and Cumming as applied to claims 15-18, 20, 22, and 43 above, and further in view of Patel et al (US 6,158,862). Patel additionally fails to disclose the use of silicone or HEMA as required by the present claims. Patel et al, however, discloses that it was known to make optics out of silicone or HEMA; see column 4, lines 7-14. Hence, it is the Examiner's position that it would have been obvious to make the optic of Patel out of silicone or HEMA for the same reasons the prior art does the same and since there is no criticality to such a selection of materials.

Response to Arguments

In response to the traversal of the Section 102/103 rejection that Patel makes the haptic of one polymer, the Examiner respectfully disagrees and notes that at least the core and sheath have a different color. Similarly, a different set of polymers is used to make the optic and the haptic; see lines 15-20 and lines 45-48 of column 4 respectively. For this reason and since the haptic can be made of the same or different material than that of the optic, it is the Examiner's position that a core of one polymer and a sheath of another polymer is suggested. Alternatively, even if the haptic core and sheath were both made with polyimide (one colored and one uncolored), the claims would be anticipated because the other type polymer (i.e. silicone, acrylic polymer, etc.) would be

Art Unit: 3738

located in the optic of the haptic core and optic combination claimed. In other words, if any part of the haptic core or optic contains the other polymer(s), then the claim language is fully met.

Applicants argue that the claims require a polyimide coating on a haptic which comprises silicone, acrylic polymer, hydroacrylic polymer, etc. However, the present claims do not require such a structure in that these polymers can be in either the haptic core or the optic.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

Art Unit: 3738

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
Art Unit 3738